

Appln No. 09/214,822
Amdt. Dated December 3, 2004
Reply to Office Communication of 06/03/2004
Docket No. 14XZ00014

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REMARKS/ARGUMENTS

This Amendment includes a request that this application be furthered considered as an RCE application.

This Amendment includes a Change of Address for the Attorney of Record.

Status of the Application:

Status of the Claims: Claims 1 to 21 have been presented for examination. Claims 1 to 21, all the pending claims, are rejected.

Claims 1 to 19 and 21 are rejected under 35 USC 103(a) as being unpatentable over the combined teachings of Robb et al., Mick et al., Kenet et al. and Gerstenberger.

Claims 1 to 21 are objected to because of noted informalities.

Claims 1 to 21 are rejected under 35 USC 112, second paragraph, because of noted indefiniteness.

Claims 1, 6, 7 and 15 are rejected under 35 USC 103(a) as being unpatentable over Robb et al. in view of Mick et al.

Claims 2 and 3 are rejected under 35 USC 103(a) as being unpatentable over Robb et al. and Mick et al. and further in view of Gerstenberger.

Claim 4 is rejected under 35 USC 103(a) as being unpatentable over Robb et al. and Mick et al. and further in view of Russ.

Claim 5 is rejected under 35 USC 103(a) as being unpatentable over Robb et al. and Mick et al. and further in view of Pratt.

Claims 8 to 14 are rejected under 35 USC 103(a) as being unpatentable over Robb et al. and Mick et al and further in view of Kenet et al.

Claims 16 to 19 and 21 are rejected under 35 USC 103(a) as being unpatentable over Robb et al.

Claims 19 and 20 are rejected under 35 USC 103(a) as being unpatentable over Robb et al. and further in view of Nields.

Status of the Declaration: The Declaration filed October 26, 1999 is acceptable.

Status of the Description: The objection to the description has been withdrawn.

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Status of the Drawings: The drawings are objected to by the Draftsperson. As noted by the Applicant in the Amendment of October 26, 2001, new drawings will be submitted upon allowance of any claim or an indication of allowable subject matter. The Examiner has not required satisfying the drawing correction.

Status of the priority claim: The Examiner has acknowledged receipt of a certified copy of the application under 35 USC 119(a)-(d) and 365 and 371.

Status of the Information Disclosure Statement: The Examiner has acknowledged receipt of the Information Disclosure Statement filed by the applicant; however, the Examiner notes that: (1) a concise explanation of a cited non-English document (FR 91 15308) has not been submitted and (2) a copy of the non-patent literature (Serra et al.) has not been submitted.

A concise explanation of FR 91 15308 will be provided in due course. Enclosed herewith is a copy of Serra et al. The applicant notes that when the Information Disclosure Statement was filed on October 26, 2001, there was then no requirement for a concise explanation of a cited non-English document.

Extension: Enclosed herewith is a Petition to Extend the term for response by month to December 3, 2004.

Objection to claims 1 to 21 because of noted informalities

The noted objections have been corrected by deleting the step identifiers and the corresponding periods. Claim 7, line 7, have been amended as proposed.

Rejection of claims 1 to 21 under 35 USC 112, second paragraph, because of noted indefiniteness.

The rejection of claims 1 and 7, "step c" is traversed. The language recited in claims 1 and 7, "step c" is correct and definite as recited and is in accordance with the Detailed Description as filed.

The rejection of claims 1 and 7, "step d" is traversed. The claim feature recites a matching of a "generated target window ... around the selected target pixels." (emphasis added). The claim feature is correct and definite and is in accordance with the Detailed Description as filed.

Claims 1, 7 and 16 have been amended to provide antecedent basis for the noted indefiniteness.

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Rejection of claims 1 to 21 under 35 USC 103(a) as being unpatentable over the combined or individual teachings of Robb et al., Mick et al., Kenet et al., Russ, Pratt and Gerstenberger.

The rejection of claims 1 to 19 and 21 under 35 USC 103(a) as being unpatentable over the combined or individual teachings of Robb et al., Mick et al., Kenet et al., Russ, Pratt and Gerstenberger is traversed for the same reasons as presented in the Amendment filed October 26, 2001.

The Court of Appeals for the Federal Circuit has repeatedly held that a rejection under 35 USC 103 must satisfy the criteria of *Graham vs. Deere*. The rejection has failed to satisfy these criteria, particularly of how the features and functions recited in the claims can be found in the cited reference and how any differences between the features and functions are obvious to one skilled in the art. It is not sufficient to merely conclude that the one skilled in the art *could* modify or adapt the cited prior art to therefore read on the features and functions recited in the claims. The Examiner must establish that one skilled in the art *would* modify or adapt the cited prior art and demonstrate the motivation or nexus of the prior art to the features and functions recited in the claims. The Examiner has alleged that the claimed invention is obvious based on a combination of prior art references. It is improper hindsight merely to "pick and choose" features from the prior art references to "arrive" at the invention as claimed. There must be a non-speculative and objective suggestion or motivation in one or more of the cited prior art to combine the features of the prior art in the manner recited in the invention as claimed. A *prima facie* of unpatentability is not established by speculating that any claim feature is found in the cited prior art simply because the word "comprising" is recited in the claim. Without this suggestion or motivation or non-speculative indication in the cited prior art the invention as claimed is unobvious and patentable in accordance with 35 USC 103.

Claim 1 has been amended to recite with greater particularity and definiteness the correlation feature that together with other features recited in claim 1, i.e., the subject matter as a whole, is not disclosed in Robb et al. or Mick et al. or Gerstenberger or Kenet et al. or Pratt or Russ. It should be noted that the cited US patent to Gerstenberger corresponds to WO92/06444 cited in the Information Disclosure Statement. in turn, WO92/06444 was cited in the International Search Report as Category A, i.e., only of "technological interest".

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Claims 2 to 6 are each dependent on claim 1 and are patentable over the cited references for the same reasons as claim 1.

Rejection of claims 19 and 20 under 35 USC 103(a) as being unpatentable over Robb et al. and further in view of Nields.

The rejection of claims 19 or 20 (or any claims) to include Nields is traversed. Nields is not qualified prior art as noted by the Examiner in paragraph 4 of the Detailed Action of the Office communication of 06/03/2004. Any rejection of any claim based on Nields is moot and should be withdrawn.

In view of the amendments to the claims, in combination with the discussions earlier regarding the rejections under 35 U.S.C. §103(a), Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a) and 35 U.S.C. §112, second paragraph, which Applicant considers to be traversed. The Applicant respectfully requests that the Examiner reconsider and withdraw all of these rejections and respectfully requests a timely Notice of Allowance with respect to claims 1 to 21.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 09-0470.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

MULLER ET AL.

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